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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,842	01/10/2005	Jong Cheol Lim	DKC 1755	2772
7590 Maria Parrish Tungol Suite 100 211 North Union Street Alexandria, VA 22314		09/27/2007	EXAMINER SZEKELY, PETER A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/520,842  
Filing Date: January 10, 2005  
Appellant(s): LIM ET AL.

**MAILED  
SEP 27 2007  
GROUP 1700**

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Maria Parrish Tungol  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/3/07 appealing from the Office action  
mailed 8/28/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Application 10/489,545, filed 3/12/04 and U.S. Patent Application 10/520,571, filed 1/7/05.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification on page 4, lines 25-28 and page 6, lines 15-26 clearly states: "consisting of" when describing ingredients ( $b_1$  and  $b_2$ ) and the blend of compounds ( $d_1$ ) and ( $d_2$ ). Broadening the limitation without having antecedent basis in the original specification is new matter.

### **(10) Response to Argument**

The original specification and claim 1 both restricted the monomer mixture ( $b_1$  and  $b_2$ ) to the ones listed in page 6, lines 15-26 and the blend of organic phosphorus compounds ( $d_1$  and  $d_2$ ) to the ones listed on page 4, lines 25-28 by using the words "consisting of". On page 9, lines 12-14, the words "consists of" is replaced by the word "is" when referring to a blend of ( $d_1$  and  $d_2$ ). Applicants first changed the phrase "consisting of" to "comprising" and then in a later response deleted the word "comprising". The specification has also been amended to delete the words "consisting of". The phrase "consisting of" has exactly the same meaning in the description and in the claims. It means that no other ingredient besides the ones listed can be present in the group described. This means that applicants had not been in possession of any other

monomers or phosphorus compounds, which can be used as ingredients ( $b_1$  and  $b_2$ ) or ( $d_1$  and  $d_2$ ) besides the ones at the locations mentioned above. The amended language permits the presence of other monomers, for example (meth)acrylic acid, vinyl acetate or cyclopentadiene or other phosphorus compounds, for example monomeric phosphates or phosphites. The original description does not mention the possibility of using other monomers or phosphorus compounds besides the ones listed and the phrase "consisting of" forbids the use of any other monomer or phosphorus compound besides the ones listed. Accordingly, the deletion of the phrase "consisting of" broadens the claims beyond the limitations of the original description and as such it clearly constitutes new matter. Since both the claims and the description are parts of the same specification, applicants' allegation that they mean different things in the description and the claims does not hold water. The presence of the phrase "consisting of" definitely teaches one of ordinary skill in the art that the materials to be used are restricted to the ones mentioned afterward. It is the legal meaning of the phrase "consisting of" which counts, a patent application is a legal document. While applicants can be their own lexicographers, they cannot change the meaning of legal terms to suit their convenience. The amended claims are broader than the original specification, the expanded limits of ( $b_1$  and  $b_2$ ) and ( $d_1$  and  $d_2$ ) have no antecedent basis in the original specification. Whether the presence of the term "consisting of" was necessary or not is completely irrelevant. Its presence in itself is proof that the exclusion of other materials is critical. It says that no other materials can be used. Its absence changes the scope of the invention. The number of U.S. Patents, which use the term "consisting of", is

Art Unit: 1714

immaterial. See *In re Giolito et al.*, 188 USPQ 645 (CCPA 1976). As far as the alleged "error" in using the phrase "consisting of" is concerned, it is an unsupported assertion by an attorney which cannot take the place of objective evidence. See *In re Pearson*, 181 USPQ 641, 646 (CCPA 1974). But even if there had been an error made transcribing the instant application from the original Korean application, said error cannot be corrected by Preliminary Amendment. Neither the Preliminary Amendment nor the Oath says anything about any error.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peter Szekely

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TC 1700